

09533906-021202

Exhibit 9 has been filed under seal under separate cover

IN THE UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

-----X
)
GEN-PROBE INCORPORATED,)
) NO. 99cv2668 H (AJB)
Plaintiff,)
VS.)
)
VYSIS, INC.,)
)
Defendant.)
-----X

CONFIDENTIAL

Videotaped Deposition of
JONATHON MICHAEL LAWRIE, Ph.D.
Durham, North Carolina
Thursday, February 15, 2001

Reported by:

Sydney C. Silva, Registered Professional Reporter

File No:

COPY

Ex. 9 Pg. 45

00533906-021202

1 A. No. 14:34:16

2 Q. Do you know whether there's any reference 14:34:17

3 in the patent to a combination of target capture 14:34:19

4 with a target-specific method of application -- of 14:34:25

5 amplification? 14:34:26

6 A. This patent here? 14:34:27

7 Q. Yes. 14:34:29

8 A. I haven't read it completely, just the 14:34:29

9 pieces you have shown me. 14:34:32

10 Q. When the patent application was filed, 14:34:34

11 did you have any impression about whether the 14:34:36

12 greatest degree of specificity sensitivity might be 14:34:38

13 obtained by combining target capture with a 14:34:42

14 target-specific method of amplification? 14:34:47

15 A. I don't remember. 14:34:56

16 Q. Does that stand to reason at all? 14:34:56

17 A. I don't think so. I don't know what the 14:34:58

18 thought process would have been back then. 14:35:00

19 Q. Can you recall any reason that a 14:35:03

20 reference to PCR might have been intentionally 14:35:05

21 omitted from the patent application? 14:35:08

22 A. Yes. 14:35:15

23 Q. And what reason was that? Let me, let me 14:35:15

24 start over. 14:35:23

Ex. 9 Pg. 46

09523906-021202

1 Was a reference to PCR intentionally 14:35:24
2 omitted from the patent to the best of your 14:35:27
3 understanding? 14:35:29
4 A. I don't know. 14:35:30
5 Q. Were there discussions about whether or 14:35:31
6 not to include a reference to PCR in the patent? 14:35:32
7 A. I can't remember. 14:35:36
8 Q. So at Amoco you had a thought about 14:35:47
9 combining target capture with PCR, is that right? 14:35:51
10 A. Yes. 14:35:54
11 Q. Gene-Trak then did work in an effort to 14:35:55
12 combine target capture with PCR, is that right? 14:35:58
13 A. From seeing this here, yes. 14:36:03
14 Q. Do you have a recollection of that? 14:36:05
15 A. No. 14:36:07
16 Q. If there's no reference in the patent to 14:36:07
17 combining target capture with PCR, do you have any 14:36:09
18 explanation as to why it is not there? 14:36:13
19 A. I believe that it was a separate -- the 14:36:15
20 thought behind this was coming up with new methods 14:36:17
21 of amplification, not old ones. 14:36:19
22 Q. And you would, for the purposes of what 14:36:31
23 you just said, you classify PCR as an old method of 14:36:32
24 amplification? 14:36:36

Ex. 9 Pg. 47

1 A. PCR itself was described in the patent, 14:36:37
2 yes, issued patent. 14:36:40
3 Q. And your understanding of the 338 patent 14:36:41
4 was that it was directed to other methods of 14:36:44
5 amplification? 14:36:47
6 A. The, it was, it was directed to the 14:36:48
7 methods disclosed by, you know, the methods 14:36:54
8 separate from PCR. 14:36:59
9 Q. Those being the methods, for example, as 14:37:07
10 the methods set forth in Example 6 and 7? 14:37:10
11 A. Yes. 14:37:14
12 Q. Is it your understanding that the 338 14:37:20
13 patent then doesn't encompass the combination of 14:37:22
14 target capture and PCR? 14:37:28
15 MR. BANKS: Object to the form. 14:37:30
16 A. I couldn't say. 14:37:31
17 Q. I'm sorry? 14:37:32
18 A. I couldn't say. 14:37:32
19 Q. Was it your intention that it encompass 14:37:33
20 the combination of target capture and PCR? 14:37:38
21 A. I don't know. I can't remember what the 14:37:40
22 intention was in regards to PCR. 14:37:41
23 Q. However, your recollection of why -- of 14:37:49
24 if there's no -- your explanation of why there 14:37:50

Ex. 9 Pg. 48

2/15/2001

Page 181

1 might not be a reference to PCR in the patent is 14:37:53
2 that the patent wasn't intended to cover old 14:37:56
3 methods of amplification such as PCR; is that 14:38:03
4 right? 14:38:06
5 A. The patent was intended to cover the 14:38:07
6 discoveries by myself, Halbert and King that there 14:38:09
7 should be in some, you know, disclosure back at 14:38:15
8 Amoco. That's what the patent was about. 14:38:16
9 why PCR was left out I can just 14:38:22
10 speculate. It wasn't what we came with, it was in 14:38:26
11 the previous, it was a previous older method. 14:38:30
12 Q. You were looking for other things? 14:38:33
13 A. Yeah. 14:38:36
14 MR. BOWEN: Let's assume that the patent 14:39:04
15 application for the 330 patent was filed on 14:39:06
16 December 21, 1987. Can we stipulate to that? 14:39:10
17 MR. BANKS: For which patent? 14:39:16
18 MR. BOWEN: The 330. 14:39:18
19 MR. BANKS: The 330? Moving to a 14:39:20
20 different one now? 14:39:21
21 MR. BOWEN: I'm confused this late in the 14:39:22
22 day, huh? The first application that claimed 14:39:25
23 the combination of target capture and 14:39:27
24 amplification. 14:39:32

Ex. 9 Pg. 49

09533906.021202

2/15/2001

Page 231

1 Example 5 is a linear method? 16:21:41
2 A. Let's see. 16:21:44
3 Yes, it is linear. 16:22:29
4 Q. So Example 5 discloses a linear 16:22:31
5 nonspecific method of amplification? 16:22:34
6 A. Yes. 16:22:37
7 Q. So recapping the examples, Examples 1 16:22:38
8 through 3 disclose capture methods without 16:22:43
9 amplification? 16:22:46
10 A. Yes. 16:22:48
11 Q. And Example 4 discloses linear 16:22:49
12 nonspecific amplification? 16:22:53
13 A. Yes. 16:22:54
14 Q. Example 5 discloses linear nonspecific 16:22:55
15 amplification? 16:22:59
16 A. Yes. 16:23:00
17 Q. Example 6 seeks to describe nonspecific 16:23:02
18 exponential amplification? 16:23:10
19 A. Let's see. Yes. 16:23:13
20 Q. And Example 7 describes -- seeks to 16:23:18
21 describe nonspecific exponential amplification? 16:23:22
22 A. Yes. 16:23:28
23 Q. Looking back at Column 30, specifically 16:23:44
24 at Lines 30 through 40, which I think is two 16:23:48

Ex. 9 Pg. 50

0533906-021202